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In re Application of KANG
U.S. Application No.: 10/585,838
PCT Application No.: PCT/KR2005/000141
Int. Filing Date: 14 January 2005
Priority Date Claimed: 15 January 2004
Attorney Docket No.: 05-518-B
For: STRUCTURE OF A MANAGEMENT
INFORMATION BASE ...

DECISION

This is in response to applicant's "Petition Under 37 C.F.R. § 1.47(b) by Person Having Proprietary Interest to File Application on Behalf of Inventor Who Cannot be Located" filed 30 April 2007.

BACKGROUND

On 14 January 2005, applicant filed international application PCT/KR2005/000141, which claimed priority of an earlier Korea application filed 15 January 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 28 July 2005. The thirty-month period for paying the basic national fee in the United States expired on 15 July 2006.

On 12 July 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 27 February 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 30 April 2007, applicant filed the present petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

With regard to item (1) above, the requisite fee has been provided.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

The petition states that inventor Kwang Seok Kang cannot be located. The petition includes an affidavit from Jiwon Lim, the person with apparent firsthand knowledge of efforts to reach Jang. Petitioner unsuccessfully tried to contact Jang through postal mail, personal visitation, and by searching telephone and Internet directories (see Lim affidavit, 7-13). Thus, it can be concluded with reasonable certainty that Kang cannot be reached after diligent effort.

With regard to item (3) above, the petition states the last known address of the nonsigning inventor.

With regard to item (4) above, an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventors has been provided.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

Under 37 CFR 3.73(b)(1), ownership of the application may be established by: (i) submitting documentary evidence of a chain of title from the original owner to the assignee; or (ii) specifying by reel and frame number where such evidence is recorded in the USPTO.

The present petition states that the inventor Kang assigned the invention to Hyundai Syscomm, Inc. ("Hyundai") and that Hyundai subsequently assigned the invention to UTStarcom Korea Limited ("UTStarcom"). Petitioner has adequately demonstrated a transfer of title from Hyundai to UTStarcom (see affidavit of Robert Irvine, Exhibit B, page 46/46). Furthermore, the petition includes an appropriate legal memorandum from attorney Joo-Young Kim which states that Hyundai would have title to the present invention instead of the inventor Kang. Therefore, a chain of title from Kang to UTStarcom has been sufficiently established.

With regard to item (6) above, the petition contains an adequate statement with regard to the preservation of rights of the parties and/or the prevention of irreparable damage.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(b) is GRANTED.

This application has an international filing date of 14 January 2005 and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 30 April 2007.

As set forth in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the nonsigning inventor at the last known address of record and will be published in the *Official Gazette*.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

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Dear Kwang Seok Kang:

You are named as the inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(b) and 35 U.S.C. 118. Should a patent be granted, you will be designated as the inventor.

As the named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost set forth in 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you choose to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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